

Remarks

Applicants have canceled claims 5, 8-10, 13, 16-20, 22-29, 32-38, 48-53 and 57-71, without prejudice, as drawn to a non-elected invention. Applicant has canceled claim 42 without prejudice. Applicant reserves the right to file one or more continuing applications to the subject matter of these claims, as well as to other canceled claims. Applicant has amended the specification at page 55 to correct the inadvertent misidentification of SEQ ID NO:29 and SEQ ID NO:30, and to indicate that SEQ ID NO:29 is an amino acid sequence, not a nucleotide sequence. Support for the amendment can be found at least in figure 10. No new matter has been added.

Rejections Under 35 U.S.C. §112, Second Paragraph

The Examiner rejected claim 42 under 35 U.S.C. §112, second paragraph.

Applicants have canceled this claim. Accordingly, Applicant respectfully requests that the Examiner withdraw the rejection made under 35 U.S.C. §112, second paragraph.

Rejections Under 35 U.S.C. §102(e)

The Examiner rejected claims 39, 42, 44, 46, 56, and 73 under 35 U.S.C. 102(e) as anticipated by US patent 6,391,311 (the “311 patent”). This patent teaches VEGF-E, a region of which is identical to Applicants’ VEGF-X sequences. Applicant respectfully requests reconsideration of the rejection.

Applicant notes that the Examiner has allowed claims 40 and 41 yet has maintained the objection to the subject matter of claims 39, 42, 44, 46, 56 and 73 on the basis that these claims are drawn to sequences consisting essentially of SEQ ID NO:26, which is a fragment of SEQ ID NO:2 of the ‘311 patent. The Examiner reasoned that because “consisting essentially of” is interpreted as equivalent to “comprising,” these claims are considered to be anticipated by SEQ ID NO:2 of the ‘311 patent.

According to MPEP § 2111.03 cited by the Examiner to support the open interpretation of the term “consists essentially of”, it is stated that “for the purposes of searching for and applying prior art under 35 U.S.C. 102 and 103, absent a clear indication in the specification or claim or what the basic and novel characteristics actually are, ‘consisting essentially of’ will be construed as equivalent to ‘comprising.’” Furthermore, the MPEP section states that “if an

applicant contends that additional steps or materials in the prior art are excluded by the recitation of 'consisting essentially of,' applicant has the burden of showing that the introduction of additional steps or components would materially change of characteristics of applicant's invention."

The claim term "consists essentially of" has been interpreted by the Court of Appeals for the Federal Circuit to mean that the claimed invention "excludes ingredients that would materially affect the basic and novel characteristics of the claimed composition." Atlas Powder Co. v. E.I. du Pont de Nemours & Co., 750 F.2d 1569, 1574, 224 USPQ 409, 412 (Fed. Cir. 1984). According to the court, the phrase is open to "unlisted ingredients that do not materially affect the basic and novel properties of the invention." PPG Indus. v. Guardian Indus. Corp., 156 F.3d 1351, 1354, 48 USPQ2d 1351, 1354 (Fed. Cir. 1998).

Applicant asserts that the specification discloses the basic and novel characteristics of the invention as now claimed. As Applicant specified in the previous response, the specification on page 19, lines 3 to 5, characteristics the CUB domain as the N terminal part of the VEGF-X protein and particularly from position 40-150 of the VEGF-X sequence illustrated in Figure 10. The CUB domain has been demonstrated to enable proliferation of HUVECs and this assay is identified on page 41, line 15 through page 42, line 13. Therefore, a polypeptide having a sequence consisting essentially of the CUB domain would function in a similar manner. It is only the N terminal part of the VEGF-X molecule that exhibits such anti-proliferative activity, as set out on page 20, lines 8-10 of the application.

Thus Applicant clearly indicated the basic and novel characteristics of the claimed invention. According to MPEP § 2111.03, then, the use of the term "consisting essentially of" is justified, and the term should not be construed as equivalent to "comprising." Therefore, the subject matter of claims 39, 42, 44, 46, 56 and 73 are not anticipated by the full length VEGF-X protein which has been shown not to have the anti-proliferative effect.

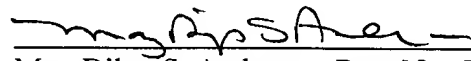
Although Applicant does not believe it to be necessary given the clear indication of the function of the CUB domain in the specification, if it would facilitate allowance Applicant would be willing to insert functional language into the claim regarding the anti-proliferative properties of the CUB domain.

Based on the foregoing arguments, Applicant respectfully requests that the Examiner withdraw the rejection made under 35 U.S.C. §102(e).

Conclusion

Applicants respectfully request reconsideration of the claims in view of the amendments and reasoned statements made above. If the Examiner wishes to advance the prosecution, or if the amendment is defective or unclear, then the Examiner is invited to telephone the undersigned at the telephone number listed below.

Respectfully submitted,
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